

REMARKS

Restriction:

It is unclear to the Applicant, why the Examiner felt that “applicant did not distinctly and specifically point out the supposed errors in the restriction requirement” Applicant specifically and distinctly indicated the errors in the Examiner’s restriction requirement including for example the typographical error omitting claims 4 - 32, and the improper election of species as it relates to claims 2 and 3, which was specifically traversed.

Claims 2 - 4 share a special technical feature namely that the ester derivative of hyaluronic acid is not sulfated. As a result, the claims have unity of invention since the claims contain a technical relationship among those inventions involving one or more of the same or corresponding special technical features. Thus Applicant respectfully requests Claim 2 and 3 to be rejoined into the pending application.

Claims

I) 35 U.S.C. § 112 ¶ 2 Rejection of Claims 17 - 19

The Office Action rejected Claims 17 – 19 under 35 U.S.C. §112 ¶2 as being indefinite for reciting the feature “active ingredient” without sufficient antecedent basis.

Claims 17 – 19 have been amended to be either directly or indirectly dependent from Claim 8, which contains the feature “active ingredient”.

The Examiner is requested to withdraw the 35 U.S.C. § 112 ¶ 2 Rejection of the Claims 17 – 19. In light of the foregoing arguments, the Examiner is respectfully requested to allow Claims 17 - 19.

II) 35 U.S.C. § 103(a) Rejections of Claims 1 - 9 and 16 - 20

The Office Action rejected Claims 1 - 9 and 16 - 20 under 35 U.S.C. 103(a) as being obvious over US6,027,741 (‘741) in view of US 6,579,978 (‘978). The Office Action states; “the ‘741 patent teaches a coated biomedical object or device having a coating of sulfated polysaccharide, wherein the polysaccharide is a hyaluronic acid” and “the ‘978 patent teaches biomaterials comprising sulphated hyaluronic acid compounds”.

Applicants have amended Claim 1 to more clearly claim the coating on the stent by adding the feature “wherein the ester derivative of hyaluronic acid is not sulfated.” The hyaluronic acid disclosed in both the ‘741 and ‘978 patents emphasize that the polymer is sulfated. The ‘741 patent specifically states that the hyaluronic acid has from 0.5 to 3.5 sulfate groups per disaccharide unit. The ‘978 patent specifically states that the hyaluronic acid has glucosamines partially N-sulphated and/or partially or totally O-sulphated in position 6.

It is proper to claim a product by use of a “negative limitation”(MPEP 2173.05(i) Negative Limitations). The courts have held that there is nothing inherently ambiguous about a negative limitation. As long as the boundaries of the claim are described definitely, even though negatively, the claim complies with the requirements of Section 112. second paragraph. *In re Wakefield* (422, F.2d 897, 164 USPQ 636 (C.C.P.A. 1970)) the CCPA held that such negative terminology was definite because each limitation was definite.

Additionally, a negative limitation does not enter New Matter. *In ex parte Williams* (39 USPQ 125, 126-27, 1938) the board stated:

“While this limitation in the protection sought is expressed in terms not to be found in the original disclosure, we see no valid objection to the appellants’ thus eliminating from the scope of the protection sought certain materials which may possibly have been included in the original disclosure. In other words, the limitation has a narrowing effect rather than a broadening one and is permissible.

The Examiner is requested to withdraw US6,027,741 in view of US 6,579,978 as 103(a) Prior Art references against Claims 1 – 9 and 16 - 20. In light of the foregoing arguments, the Examiner is respectfully requested to allow Claims 1 – 9 and 16 – 20. .

III) 35 U.S.C. § 103(a) Rejections of Claims 11 – 14 and 17 - 19

The Office Action rejected Claims 1 – 9 and 16 - 20 under 35 U.S.C. 103(a) as being obvious over US6,027,741 (‘741) in view of US 6,579,978 (‘978), further in view of US2002/082679.

Applicants amended Claim 1, as discussed above, to add the feature that the ester derivative of hyaluronic acid is not sulfated. US2002/082679 does not disclose this missing

feature in '741 and '978, and as such, the combination of these references does not disclose each every feature of Claim 1. Claims 11 – 14 and 17 – 19 are indirectly dependent from Claim 1 and contain all the features of Claim 1. Therefore, the combination of '741, '978 and US2002/082679 does not disclose each and every feature of Claims 11 – 14 and 17 – 19.

The Examiner is requested to withdraw US6,027,741 in view of US 6,579,978, further in view of US2002/082679 as 103(a) Prior Art references against Claims 11 – 14 and 17 – 19. In light of the foregoing arguments, the Examiner is respectfully requested to allow Claims 11 – 14 and 17 – 19.

IV) 35 U.S.C. § 103(a) Rejections of Claims 20 – 23, 25 – 26 and 28 - 32

The Office Action rejected Claims 20 – 23, 25 – 26 and 28 - 32 under 35 U.S.C. 103(a) as being obvious over US6,027,741 ('741) in view of US 6,579,978 ('978) and US2002/082679 and further in view of US6,129,956 ('956).

Applicants amended Claim 1, as discussed above, to add the feature that the ester derivative of hyaluronic acid is not sulfated. The '956 patent does not disclose this missing feature in '741, '978 and US2002/082679, and as such, the combination of these references does not disclose each every feature of Claim 1. Claims 20 – 23, 25 – 26 and 28 - 32 are directly or indirectly dependent from Claim 1 and contain all the features of Claim 1. Therefore, the combination of '741, '978, US2002/082679 and '956 does not disclose each and every feature of Claims 20 – 23, 25 – 26 and 28 - 32.

The Examiner is requested to withdraw US6,027,741 in view of US 6,579,978 and US2002/082679, further in view of US6,129,956 as 103(a) Prior Art references against Claims 20 – 23, 25 – 26 and 28 - 32. In light of the foregoing arguments, the Examiner is respectfully requested to allow Claims 20 – 23, 25 – 26 and 28 - 32.

V) 35 U.S.C. § 103(a) Rejection of Claim 24

The Office Action rejected Claim 24 under 35 U.S.C. 103(a) as being obvious over US6,027,741 ('741) in view of US 6,579,978 ('978), US2002/082679 and US6,129,956 ('956), further in view of Vercruysse 1998.

Applicants amended Claim 1, as discussed above, to add the feature that the ester derivative of hyaluronic acid is not sulfated. Vercruysse 1998 does not disclose this missing feature in '741, '978, US2002/082679 and '956, and as such, the combination of these references does not disclose each every feature of Claim 1. Claim 24 is indirectly dependent from Claim 1 and contains all the features of Claim 1. Therefore, the combination of '741, '978, US2002/082679, '956 and Vercruysse 1998 does not disclose each and every feature of Claim 24.

The Examiner is requested to withdraw US6,027,741 ('741) in view of US 6,579,978 ('978), US2002/082679 and US6,129,956 ('956), further in view of Vercruysse 1998 as 103(a) Prior Art references against Claim 24. In light of the foregoing arguments, the Examiner is respectfully requested to allow Claim 24.

VI) 35 U.S.C. § 103(a) Rejection of Claims 10 and 15

The Office Action rejected Claims 10 and 15 under 35 U.S.C. 103(a) as being obvious over US6,027,741 ('741) in view of US 6,579,978 ('978) and US2002/082679, further in view of WO99/03854.

Applicants amended Claim 1, as discussed above, to add the feature that the ester derivative of hyaluronic acid is not sulfated. WO99/03854 does not disclose this missing feature in '741, '978, and US2002/082679, and as such, the combination of these references does not disclose each every feature of Claim 1. Claims 10 and 15 is indirectly dependent from Claim 1 and contains all the features of Claim 1. Therefore, the combination of '741, '978, US2002/082679 and WO99/03854 does not disclose each and every feature of Claims 10 and 15.

The Examiner is requested to withdraw US6,027,741 ('741) in view of US 6,579,978 ('978), and US2002/082679, further in view of WO99/03854 as 103(a) Prior Art references against Claims 10 and 15. In light of the foregoing arguments, the Examiner is respectfully requested to allow Claims 10 and 15.

VII) 35 U.S.C. § 103(a) Rejection of Claim 27

The Office Action rejected Claim 27 under 35 U.S.C. 103(a) as being obvious over US6,027,741 ('741) in view of US 6,579,978 ('978), US2002/082679 and US6,129,956 ('956),

further in view of WO99/03854.

Applicants amended Claim 1, as discussed above, to add the feature that the ester derivative of hyaluronic acid is not sulfated. WO99/03854 does not disclose this missing feature in '741, '978, US2002/082679 and '956, and as such, the combination of these references does not disclose each every feature of Claim 1. Claim 27 is indirectly dependent from Claim 1 and contains all the features of Claim 1. Therefore, the combination of '741, '978, US2002/082679, '956 and WO99/03854 does not disclose each and every feature of Claim 27.

The Examiner is requested to withdraw US6,027,741 ('741) in view of US 6,579,978 ('978), US2002/082679 and US6,129,956 ('956), further in view of WO99/03854 as 103(a) Prior Art references against Claim 27. In light of the foregoing arguments, the Examiner is respectfully requested to allow Claim 27.

CONCLUSION

Claims 1 – 42 are Pending. Claims 2 - 16 and 20 – 32 are Original. Claims 1 and 17 – 19 are Currently amended. Claims 33 and 37 are Withdrawn – Currently amended. Claims 34 – 36 and 38 - 42 are Withdrawn. No New Matter was entered with these amendments. Applicants respectfully request the entrance of the amendments.

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, arguments in support of the patentability of the pending claim set are presented above. In light of the above remarks, reconsideration and withdrawal of the outstanding rejections are specifically requested and it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

No additional fees are believed due; however, the Commissioner is authorized to charge any fees due in connection with the filing of this response to our Deposit Account No. 50-1349. If a fee is required for an extension of time under 37 C.F.R. § 1.136 that is not accounted for in the enclosed transmittal, such an extension is requested and the fee should also be charged to our Deposit Account.

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